



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

m/

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/758,939	01/10/2001	Jennifer Lu	5075-0028	9598

23980 7590 12/11/2006

MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C
1400 PAGE MILL ROAD
PALO ALTO, CA 94304-1124

EXAMINER

MAGEE, CHRISTOPHER R

ART UNIT PAPER NUMBER

2627

DATE MAILED: 12/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/758,939

Applicant(s)

LU ET AL.

Examiner

Christopher R. Magee

Art Unit

2627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27, 40 and 41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-27 and 41 is/are allowed.
- 6) ☒ Claim(s) 40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

- Claim 40 is rejected under 35 U.S.C. 102(e) as being anticipated by Zheng et al. (hereinafter Zheng) (US 6,870,707 B1).

Regarding claim 40, Zheng discloses a method for producing a transducer slider having at least one rounded corner [col. 4, lines 54-55], comprising:

- (a) coating a substrate with a radiation-sensitive layer [col. 9, lines 17-18];
- (b) imagewise exposing the radiation-sensitive layer to radiation according to an intensity pattern having a gradient conforming to said at least one tapered edge, said intensity pattern enabling specific levels of removal of portions of the radiation sensitive layer corresponding to the specific intensity pattern used [col. 9. lines 19-29];
- (c) developing the image into the radiation-sensitive layer [col. 9, lines 30-37]; and
- (d) transferring the image into the substrate to form a transducer slider having a surface profile comprising said at least one rounded corner as provided by the specific intensity pattern [Figs. 3A-E and 4A-C; col. 4, lines 54-55].

Allowable Subject Matter

2. Claims 1-27 and 41 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: Claim 1 specifies a method for producing a transducer slider having at least one tapered edge, which requires "wherein the predetermined surface profile contains no exposed sharp edge which might contact a disk surface when the transducer slider is in use." The closest prior art of record, Zheng et al. (hereinafter Zheng) (US 6,870,707 B1), discloses in Figs. 3A-E and 4A-C a method for producing a transducer slider having at least one tapered edge but does not exemplify the predetermined surface profile contains no exposed sharp edge which might contact a disk surface when the transducer slider is in use as claimed in the present invention.

Response to Arguments

3. Applicant's arguments filed on 09/29/2006 have been fully considered but they are not persuasive. On page 7 of the Remarks, the Applicant asserts:

"The Zheng reference fails to disclose the limitation of claim 1 requiring no exposed sharp edge which might contact a disk in use. Zheng also fails to disclose the limitation of claim 40 requiring a rounded corner.

The figures of Zheng show that Zheng contemplated only straight sharp edges. The Examiner has identified a single passage in Zheng, col. 4, lines 54-55, as supporting the view that the rounded corner requirement of claim 40 is found in Zheng. (Office Action at 2.) That passage, however, states in its entirety: "Leading taper 238 can be linear or curved, for example." If one examines FIG. 2 of Zheng where leading taper 238 is shown, one will see that just making it curved will generally not produce rounded edges nor eliminate sharp ones. To eliminate sharp edges one would have to do much more than just make taper 238 curved: one would also have to give taper 238 a convex profile which meets other surfaces of the slider relatively smoothly without edge, a type of profile not suggested or taught by Zheng.

For these reasons, Zheng does not anticipate or make obvious claims 1 and 40, or the claims dependent on them, as presently amended."

Art Unit: 2627

The Examiner maintains that Zheng teaches a method for producing a transducer slider having at least one rounded corner [col. 4, lines 54-55]. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., To eliminate sharp edges one would have to do much more than just make taper 238 curved: one would also have to give taper 238 a convex profile which meets other surfaces of the slider relatively smoothly without edge) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 2627

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher R. Magee whose telephone number is (571) 272-7592. The examiner can normally be reached on M-F, 8: 00 am-4: 30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea Wellington can be reached on (571) 272-4483. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christopher R. Magee
Patent Examiner
Art Unit 2627

December 5, 2006
crm


ANDREA WELLINGTON
SUPERVISORY PATENT EXAMINER